

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Bixler, et al. Confirmation No. 2528
Serial No.: 10/719,489 Group Art Unit: 1712
Filed: November 21, 2003 Examiner: Moore, Margaret
Title: INTEGRATED PROCESS FOR PREPARING A SILICONE
RUBBER COMPOSITION

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

Subsequent to the mailing of an Examiner's Answer on November 28, 2006, Applicants now submit a Reply Brief in response to the Examiner's Answer in accordance with 37 CFR §41.41. It is believed that no additional fees are due. However, the Patent Office is authorized to charge or refund any fee deficiency or excess to Deposit Account No. 08-2789.

REMARKS

In reply to the Examiner's Answer, the Applicants offer the following remarks, which are meant to supplement the substance of the Appeal Brief.

The Applicants concur, in principle, with the Examiner's assessment of the main issue on Appeal; however, the Applicants wish to clarify that, rather than as the Examiner has termed the issue as being "the obviousness of claimed step B)", the main issue is actually the obviousness of independent claim 1 as a whole. The Applicants acknowledge that claim step B) is the claimed step that distinguishes independent claim 1 from Bilgrien et al., which was relied upon by the Examiner to render the present rejection. However, as the Board is well aware, a proper claim analysis must take into account the claim as a whole rather than dissecting the claim into individual elements for isolated analysis. See MPEP 2106(II)(C).

The Applicants maintain that the Examiner's application of the principles set forth in *In re Dilnot*, 319 F.2d 188 (CCPA 1963) remains wrought with errors, and that the Examiner is attempting to shoe-horn the present case to fit the situation in *In re Dilnot*. The Examiner is not willing to recognize the crucial distinction between a situation where process steps are merely drawn out to make a batch process into a continuous process **with no new or additional steps** (as in *In re Dilnot*), and the situation where **an additional or new** process step is claimed that happens to make it *possible* to convert a batch process into a continuous process (as in the present case). The additional or new step in the process claimed in independent claim 1 has additional advantages beyond merely rendering a prior art batch process continuous. As discussed in detail in the Appeal Brief, by directly transferring the powder composition to a bulk solids cooling

device, processing time is substantially reduced.

The reduction in processing time is independent of whether or not the process is performed in a batch or a continuous manner. If the process is performed as a batch process, the batch could simply be completed in less time than similar prior art processes. As such, it is clear that the differences between independent claim 1 and Bilgrien et al. amount to more than merely the difference between a batch process and a continuous process, and the Examiner is clearly wrong in her assessment.

Further, in the present case, **there is nothing in independent claim 1 that even requires the presently claimed process to be continuous**; the present claims also cover batch processes in which each of the claimed steps is performed. Stated differently, independent claim 1 does not rely on the claimed process to be continuous to distinguish over the closest prior art, which is represented by Bilgrien et al. The fact that the Examiner can permutate independent claim 1 to find that it could *possibly* render what was once a batch process into a continuous process does not change the fact that independent claim 1 distinguishes over Bilgrien et al. regardless of whether or not the process is employed in a continuous manner or not.

With regard to the Examiner's statements concerning a "demonstrated criticality", the Applicants assert that the Examiner is again off-base with her assessment of the established case law and interpretation of the Applicants' arguments. The sections in the Applicants' Appeal Brief that the Examiner refers to were merely included to aid the Examiner in understanding the proper standard for analysis under *In re Dilnot* and to illustrate the limitations of *In re Dilnot*. To further clarify, *In re Dilnot* takes into account criticality of specific limitations **only once it has been determined** that the difference

between the prior art and the claimed process is merely the difference between a batch process and a continuous process, and the demonstrated criticality can overcome obviousness **even if** the difference between the prior art and the claimed invention is only the difference between a batch process and a continuous process. In the present case, the Applicants have clearly shown that the difference between the prior art and the invention claimed in independent claim 1 is more than merely a difference between a continuous process and a batch process, thus rendering moot any issues of criticality in terms of the analysis under *In re Dilnot*.

In view of the remarks set forth in the Appeal Brief, as well as the additional remarks set forth above, it is clear that the Examiner cannot use the “shortcut” provided by *In re Dilnot* to establishing obviousness of independent claim 1. Thus, the Examiner must adhere to the well established principles for establishing a *prima facie* case of obviousness of the present case, which the Examiner has also failed to do. The Applicants refer to prior remarks set forth in the Appeal Brief, which clearly set forth the standard for establishing that prior art references are analogous art that can be properly combinable. Notably, while the Examiner has focused on the fact that Bilgrien et al. and Boudreau et al. are classified in the same class/subclass, the MPEP clearly establishes that **similarities and differences in structure and function carry more weight** than common classification. See MPEP 2141.01(a)(II.)

The Applicants have noted numerous differences between the structure and function of powdered or particulate siloxanes (which were the focus of Bilgrien et al.) and liquid siloxanes (as were the focus of Boudreau et al), especially as the differences affect the manner in which the powdered or particulate siloxanes and liquid siloxanes are

prepared. In response, the Examiner has attempted to establish that the powdered or particulate siloxanes and liquid siloxanes are analogous by relying on viscosity of the respective siloxanes. By pointing to similarities in viscosities between the powdered or particulate siloxanes in Bilgrien et al. and liquid siloxanes of Boudreau et al., the Examiner is ignoring glaring differences between the physical properties of powdered or particulate siloxanes and liquid siloxanes to find scant similarities where few, if any, exist. Specifically, the Examiner has failed to explain how similar viscosities would overcome the fundamental differences between powdered or particulate siloxanes and liquid siloxanes. Such fundamental differences greatly affect the manner in which the powdered or particulate siloxanes and the liquid siloxanes are prepared. As one example, massing must be considered when preparing powdered or particulate siloxanes (as in Bilgrien et al.), whereas massing is immaterial for preparation of liquid siloxane (as in Boudreau et al.). The Examiner has ignored these differences, among many other differences specified in the Appeal Brief, and has gone to great lengths to pick and choose only so much from the disclosures and teachings of Bilgrien et al. and Boudreau et al. as will support her position that those references are analogous without considering the teachings of those references as a whole.

Even if the Board were to maintain that Bilgrien et al. and Boudreau et al. are properly combinable, the Examiner **still** has not met the burden of establishing a *prima facie* case of obviousness with regard to independent claim 1. Namely, the Examiner has still not established that there is a teaching, suggestion, or motivation to make the asserted combination of Bilgrien et al. and Boudreau et al., which requires that the prior art suggest the **desirability** of making the asserted combination. See MPEP 2141(II).

The Examiner is again attempting to take impermissible shortcuts to satisfy her burden. In particular, in the last paragraph on page 7 of the Examiner's Answer, the Examiner indicates that "Boudreau et al. is relied upon only to the extent that it demonstrates that continuous methods of compounding silicone and silica by transferring the product to a separate cooling device are, in fact, known in the art . . . [and that] the claimed step of transferring, on its own, is not one that is novel and completely new to the art of silicone rubbers." The Applicants are not aware of any rule or guidance in the MPEP that allows the Examiner to establish *prima facie* obviousness through such conclusory statements and without providing any reasoning whatsoever as to motivation, teaching, or suggestion within the prior art to make the asserted combination of prior art references. In fact, the Examiner has completely failed to explain **why** one of skill in the art, when faced with the problems associated with powdered or particulate siloxanes, would be motivated to look to liquid siloxane art (Boudreau et al.) to remedy deficiencies with regard to the powdered or particulate siloxane art. The Applicants assert that not only would one of skill in the art **not** be motivated to cross from powdered or particulate siloxane art into liquid siloxane art or vice versa, **especially** when dealing with processes of preparing powdered or particulate siloxanes, but the prior art further **does not suggest the desirability of making the asserted combination**. The Applicants assert that the required showing of desirability to make the asserted combination **cannot** be established, especially in view of the well-established differences between powdered or particulate siloxanes and liquid siloxanes, as well as the different processing considerations that are involved with each.

In view of the foregoing, it is clear that the Examiner cannot establish a *prima*

facie case of obviousness with regard to independent claim 1 over the combination of Bilgrien et al. and Boudreau et al., and the rejection of independent claim 1, and the claims which depend therefrom, cannot be maintained and must be withdrawn.

The Commissioner is authorized to charge the Deposit Account No. 08-2789, in the name of Howard & Howard Attorneys, P.C., for any fees or credit the account for any overpayment.

Respectfully submitted,

HOWARD & HOWARD ATTORNEYS, P.C.

January 26, 2007

Date

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